

REMARKS

Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 are pending in the application. Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 stand rejected. Applicant herein amend claims 1, and 23. No new matter has been added. Further review is respectfully requested in view of the amendments and following remarks.

I. Telephonic Interview 1/29/2008

Applicants' representative thanks the Examiner for granting an interview conducted *via* telephone on January 29, 2009. In this regard, Applicants' representative appreciates the Examiner's discussion regarding how to overcome the 35 U.S.C. §101 rejection.

II. Rejection of Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 Under 35 U.S.C. § 101

Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 stand rejected under 35 U.S.C. §101 because the Examiner asserts that the claims lacks "practical application" and "real world results." (Office Action pg 5). Applicant's representative disagrees for the following reasons.

First, Applicant's representative respectfully submit that the present claims does provide real world result and provides practical applications.

As stated in the specification,

"the invention of explicit interface member implementation provides a solution to a number of shortcoming in the prior art, namely the lack of ability to handle implementation of two independently-developed and conflicting interfaces, the lack of ability to privately implement an interface, and the lack of ability to specifically implement generic explicit interface member." (Pg 8, line 12-16)

In one particular example, the use of private interface member implementation will avoid cluttering up class definitions. The specification states: "the class consumer does not see an F method on C. The omission of this member provides value to the developer of C. The lack of an F helps call attention to the method G, which is what consumer should actually be

concerned with.” (pg 19, Line 25-31). Thus, the subject claims clearly provides practical application and real world results.

Second, Applicants’ representative respectfully submit that the “useful, concrete and tangible result” test is no longer sufficient for determining whether a claim satisfies §101. Rather, the proper test is be the machine-or-transformation test. *In re Bilski*, 545 F.3d 943 , 20 (Fed. Cir. 2008)(en banc).

“ [T]he proper inquiry under §101 is not whether the process claim recites sufficient “physical steps,” but rather whether the claim meets the machine-or-transformation test... a claim that purportedly lacks any “physical steps” but is still tied to a machine or achieves an eligible transformation passes muster under §101.” (*In re Bilski* at 23.) “The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transform an article.” (*Id.* at 10, citing *Gottschalk v. Benson*, 409 U.S. 63, 70, 93 S. Ct. 253, 34 L. Ed. 2d 273 (1972)).(emphasis added).

As is clear from the claim language, all the steps as recited by claim 1 (and similarly claims 23 and 61), are tied to a machine. (e.g., “A method for configuring a computer to generate computer executable instructions”) More importantly, the steps involve generating computer executable instructions. At least one computer device is required by claim 1 in order to generate such computer executable instructions and thus is not a insignificant part of the claim. (*See Parker v. Flook*, 437 U.S. 584, 590, 98 S. Ct. 2522, 57 L. Ed. 2d 451 (1978). Claims 2-3, 6-15, 17-19, 24-26, 28-37, 39-41, 58-60, 62-63, and 66-75 depend from claims 1, 23, and 61 respectively, and are believed to be statutory for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 Under 35 U.S.C. § 102(a)

Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 stand rejected under 35 U.S.C. §102(a) as being anticipated by Ecma standard “Draft C# Language Specification (“Ecma”). Withdrawal of this rejection is respectfully requested for at least the following reasons. The subject matter as claimed was invented prior to the effective date of the Ecma.

In view of the declaration submitted herewith under 37 C.F.R. §1.131 by Scott Wiltamuth, Anders Hejlsberg, Peter H. Golde, Peter F. Sollich, Applicants’ representative respectfully submit that the subject matter of the present application was invented prior to the printed date, March 2001. The attached declaration is accompanied by copies of supporting records. The Examiner is respectfully urged to carefully review the attached declaration, which is signed by all the inventors of the present application, and to withdraw the rejections based on Ecma. Accordingly, Applicant respectfully requests that the rejection of claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 under 35 U.S.C. § 102 (a) be reconsidered and withdrawn.

Should the Examiner for any reason feel that the declaration is insufficient, or that additional information is required, the Examiner is respectfully encouraged to call Applicants’ representative at the phone number provided below.

IV. Rejection of Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 Under 35 U.S.C. § 103(a)

Claims 1-3, 6-15, 17-19, 23-26, 28-37, 39-41, 58-63, and 66-75 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ecma. Withdrawal of the rejection is requested for at least the following reasons.

The subject matter as claimed was invented prior to the effective date of the Ecma in view of the declaration submitted herewith under 37 C.F.R. §1.131. Further more, the Examiner felt that the computer readable medium feature as recited in the subject claim is obvious to one of skilled in the arts. As stated in MPEP section 715.02:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim... Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), *an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows*. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, *where the examiner*, in rejecting a claim under 35 U.S.C. 103, *has treated a claim limitation as being an obvious feature* or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, *a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification*.

Accordingly, the declaration submitted herewith under 37 C.F.R. §1.131 is sufficient to overcome this rejection because the subject matter of the present application was invented prior to the printed date of the cited reference. Reconsideration and withdrawal of the rejections to claims is earnestly solicited.

Any amendments made during prosecution of the pending application are without abandonment of subject matter. Applicants expressly reserve the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

DOCKET NO.: MSFT-0573/160076.01
Application No.: 09/900,123
Office Action Dated: August 15, 2008

PATENT

CONCLUSION

Applicants request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

Date: February 13, 2009

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